Vulcan Golf, LLC v. Google Inc. et al Doc. 197

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

VULCAN GOLF, LLC, JOHN B. SANFILLIPPO & SON, INC., BLITZ REALTY GROUP, INC., and VINCENT E. "BO" JACKSON, individually and on behalf of all others similarly situated,	§	
	§	Civil Action No.: 07-C-3371
Lead Plaintiff,	§	
	§	Hon. Blanche M. Manning
v.	§	
	§	
GOOGLE INC., OVERSEE.NET, SEDO LLC, DOTSTER, INC., a/k/a REVENUEDIRECT.COM, INTERNET REIT, INC. d/b/a IREIT, INC., and JOHN DOES I-X,	§	
	§	
Defendants.	§	

MEMORANDUM OF LAW IN SUPPORT OF
PLAINTIFFS' MOTION FOR CLASS CERTIFICATION

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TABLE OF CONTENTS

Table of Authorities iii

PRELIMINARY STATEMENT 1

Plaintiffs' Claims 1

Defendants' Deceptive Domain Scheme 3

ARGUMENT 4

I. Standards for Evaluating Motions for Class Certification 4

II. Class Definition 5

III. The Proposed Class Meets the Requirements of Rule 23(a) 6

A. The Numerosity Requirement is Satisfied 6

B. The Commonality and Typicality Requirements Are Satisfied 7

C. The Named Plaintiffs and Their Counsel will Fairly and Adequately Represent the Interests of the Class 9

D. The Class is Ascertainable 10

IV. The Proposed Class Meets the Requirements of Rule 23(b) 17

A. The Class Meets the Requirements of Rule 23(b)(3) 17

1. Common Questions Predominate Over Questions Affecting Only Individual Members of the Class 17

(a) The Class Member's Claims All Arise from Defendants' Common Course of Conduct 18

(b) Individual Issues Do Not Predominate 21

2. A Class Action is the Superior Method for Adjudicating these Claims 25

B. The Class also Satisfies the Requirements of Rule 23(b)(2) 28

C. The Class also Satisfies the Requirements of Rule 23(b)(1) 29

V. Each Class Representative has Standing as to All Defendants...30

CONCLUSION...33

TABLE OF AUTHORITIES

CASES

In re Abbott Laboratories Norvir Antitrust Litig.,
2007 WL 1689899 (N.D. Cal. June 11, 2007) 20, 24

In re Activision Sec. Litig.,
621 F. Supp. 415 (N.D. Cal. 1985) 18

Allen v. City of Chicago,
828 F. Supp. 543 (N.D. Ill. 1993) 10

Alliance to End Repression v. Rockford,
565 F.2d 975 (7th Cir. 1977) 11, 12, 13

Allison v. Citgo Petroleum Corp.,
151 F.3d 402 (5th Cir. 1998) 29

Amchem Products, Inc. v. Windsor,
521 U.S. 591 (1997)...4, 6

America Online Latino v. American Online, Inc.,
250 F. Supp. 2d 351 (S.D.N.Y. 2003)...27

Blackie v. Barrack,
524 F.2d 891 (9th Cir. 1975) 21

Chamberlan v. Ford Motor Co.,
223 F.R.D. 524 (N.D. Cal. 2004)..20

Chandler v. Southwest Jeep-Eagle, Inc.,
162 F.R.D. 302 (N.D. Ill. 1995)..18

Christakos v. Intercounty Title Co.,
196 F.R.D. 496 (N.D. Ill. 2000)...10, 11, 16

Contact Buyers League v. F. & F. Investment,
300 F. Supp. 210 (N.D. Ill. 1969) 31

Cox v. Joe Rizza Ford, Inc.,
1996 WL 65994 (N.D. Ill. February 9, 1996)..17, 25, 27

David v. Showtime/The Movie Channel, Inc.,
697 F. Supp. 752 (S.D.N.Y. 1988)...9, 23, 30

Day v. Check Brokerage Corp.,
240 F.R.D. 414 (N.D. Ill. 2007)....................11

De La Fuente v. Stokely-Van Camp, Inc.,
713 F.2d 225 (7th Cir. 1983)....................8

Doe v. County of Montgomery,
41 F.3d 1156 (7th Cir.1994)....................30

Dupler v. Costco Wholesale Corp.,
249 F.R.D. 29 (E.D.N.Y. 2008)....................20

Eisen v. Carlisle & Jacquelin,
391 F.2d 555 (2d Cir. 1968)....................5, 10

Flanagan v. Allstate Ins. Co.,
42 F.R.D. 421, 427 (N.D. Ill. 2007)....................5

Franklin v. City of Chicago,
102 F.R.D. 944 (N.D. Ill. 1984)....................7

George v. Kraft Foods Global,
__ F.R.D. __, 2008 WL 2901058 (N.D. Ill. July 17, 2008)....................28

Gilbert v. First Alert, Inc.,
904 F. Supp. 714 (N.D. Ill. 1995)....................5

Gulf Oil Co. v. Bernard,
452 U.S. 89 (1981)....................4

Hanlon v. Chrysler Corp.,
150 F.3d 1011 (9th Cir. 1998)....................9

Haywood v. Barnes,
109 F.R.D. 568 (E.D.N.C. 1986)....................11

Hilao v. Estate of Marcos,
103 F.3d 767 (9th Cir. 1996)....................22

Hinman v. M and M Rental Center,
545 F. Supp. 2d 802 (N.D. Ill. 2008)....................11, 16

Holmes v. Continental Can Co.,
706 F.2d 1144 (11th Cir. 1983)....................29

Hudson v. Chicago,
242 F.R.D. 496 (N.D. Ill. 2007)..........31

Illinois Migrant Council v. Pilliod,
540 F.2d 1062 (7th Cir. 1976), *modified in part on rehearing en banc*,
548 F.2d 715 (7th Cir. 1977)..........12

Jefferson v. Ingersoll International, Inc.,
195 F.3d 894 (7th Cir. 1999)..........29

Jeffries v. Pension Trust Fund,
2007 WL 2454111 (S.D.N.Y. Aug. 20, 2007)..........11

Kelly v. Microsoft Corp.,
__ F. Supp. 2d __, 2008 WL 509332 (W.D. Wash. 2008)..........20

Lau v. Arrow Financial Services,
245 F.R.D. 620 (N.D. Ill. 2007)..........11

Leelanau Wine Cellars, Ltd. v. Black & Red, Inc.,
502 F.3d 504 (6th Cir. 2007)..........24

Lemon v. International Union of Operating Engineers, Local No. 139,
216 F.3d 577 (7th Cir. 2000)..........28

Local Joint Executive Board Of Culinary/Bartender Trust Fund v. Las Vegas Sands, Inc.,
244 F.3d 1152 (9th Cir. 2001)..........21

Lujan v. Defenders of Wildlife,
504 U.S. 555 (1992)..........30

Mace v. Van Ru Credit Corp.,
109 F.3d 338 (7th Cir. 1997)..........4

Marcial v. Coronet Ins. Co.,
880 F.2d 954 (7th Cir. 1989)..........6

Mejdreck v. The Lockformer Co.,
2002 WL 1838141 (N.D. Ill. Aug. 12, 2002)..........28

In re Methyl Tertiary Butyl Ether ("MTBE") Prod. Liability Litig.,
241 F.R.D. 185 (S.D.N.Y. 2007)..........11

Meyer v. Citizens and Southern National Bank,
106 F.R.D. 356 (M.D. Ga. 1985) 11

Murray v. Cingular Wireless II, LLC,
242 F.R.D. 415 (N.D. Ill. 2005) 21

In re Napster, Inc. Copyright Litig.,
2005 WL 1287611 (N.D. Cal. June 1, 2005) .... *passim*

National Organization for Women v. Scheidler,
172 F.R.D. 351 (N.D. Ill. 1997) 11

In re New England Mutual Life Ins. Co. Sales Practices Litig.,
83 F.R.D. 33 (D. Mass. 1998) 23

Ortiz v. Fibreboard Corp.,
527 U.S. 815 (1999) 30

Panache Broadcasting of Pennsylvania, Inc. v. Richardson Electronics, Ltd.,
1999 WL 342392 (N.D. Ill. May 14, 1999) 22

Payton v. County of Kane,
308 F.3d 673 (7th Cir. 2002) 30, 31

Richards v. FleetBoston Financial Corp.,
238 F.R.D. 345 (D. Conn. 2006) 29

Ringswald v. County of DuPage,
196 F.R.D. 509 (N.D. Ill. 2000) 6, 7

Rogers v. Baxter Intern,
2006 WL 794734 (N.D. Ill. March 22, 2006) 5

Rosario v. Livaditis,
963 F.2d 1013 (7th Cir. 1992) 7, 8

Ryan v. Carl Corp.,
1999 WL 16320 (N.D. Cal. Jan. 13, 1999) 23

Schumacher v. Tyson Fresh Meats,
221 F.R.D. 605 (D.S.D. 2004) 24

Siemer v. Associates First Capital Corp.,
2001 WL 35948712 (D. Ariz. March 30, 2001) 20

Swanagan v. Al Piemonte Ford Sales, Inc.,
1995 WL 493480 (N.D. Ill. August 15, 1995) 17

In re Terazosin Hydrochloride Antitrust Litig.,
220 F.R.D. 672 (S.D. Fla. 2004) 20

Thomas v. Arrow Financial Services, LLC,
2006 WL 2438346 (N.D. Ill. August 17, 2006) 18

Tylka v. Gerber Products Co.,
178 F.R.D. 493 (N.D. Ill. 1998) 28

Vergara v. Hampton,
581 F.2d 1281 (7th Cir. 1978), *cert. denied*, 441 U.S. 905 (1978) 11

Visa Check/Mastermoney Antitrust Litig.,
280 F.3d 124 (2d. Cir. 2001) 21

Von Moore v. Simpson,
1997 WL 570769 (N.D. Ill. Sept. 10, 1997) 17, 18

Weiss v. Winners Circle,
1995 WL 755328 (N.D. Ill. 1995) 31

Westefer v. Snyder,
2006 WL 2639972 (S.D. Ill. Sept. 12, 2006) 28

Xiufang Situ v. Leavitt,
240 F.R.D. 551 (N.D. Cal. 2007) 16

UDRP CASES

Google, Inc. v. wwwgoogle.com and Jimmy Siavesh Behain,
WIPO UDRP Case No. D2000-1240 14

Google, Inc. v. Xtraplus Corp.,
WIPO UDRP Case No. D2001-0125 15

Google, Inc. v M Minnebreuker,
WIPO Case DNL2008-0012 15

Google Inc. v. Office Manager a/k/a H. Hunchak,
NAF UDRP Case No. FA0205000113964 15

Google Inc. v. Dmitri Rytsk,
WIPO UDRP Case No. DAU2007-0004 15

Google Inc. v Mikel M Freije,
NAF UDRP Case No. FA0111000102609 15

Google Technology Inc. v. Internet Hispano, S.L.,
NAF UDRP Case No. FA0307000176533 15

Google, Inc. v. Raffaele Bassano,
NAF UDRP Case No. FA0401000232958 15

Google, Inc. v. Namerental.com and Leonard Bensonoff,
WIPO UDRP Case No. D2001-0060 15

Google, Inc. v. Goog LR f/k/a Seocho,
NAF UDRP Case No. FA0108000098462 16

Google Technology Inc. v. Tenacia Technologies c/o Matthew Graves,
NAF UDRP Case No. FA0306000162059 16

STATUTES

15 U.S.C. § 1117(d) 22

15 U.S.C. § 1125(d)(1)(a) 14

15 U.S.C. § 1125(d) 1, 7

LEGISLATIVE HISTORY

145 Cong. Rec. H10828 (1999) 1

145 Cong. Rec. S10515 (1999) 2

PRELIMINARY STATEMENT

This Court has sustained ten of the causes of action brought by Plaintiffs Vulcan Golf, LLC, John B. SanFillipo & Son, Inc., Blitz Realty Group and Vincent E. "Bo" Jackson. Plaintiffs now seek class certification with respect to four of those causes of action: Count IV (cybersquatting in violation of the ACPA, 15 U.S.C. § 1125(d)), Counts IX and X (contributory and vicarious trademark infringement) and Count XII (unjust enrichment).

Plaintiffs' Claims

In 1999, Congress passed the Anticybersquatting Consumer Protection Act ("ACPA"), which provided a new cause of action under the Lanham Act. The new cause of action, which focused explicitly on domain names, was intended to protect mark owners and to foster consumer confidence in and promote growth of the Internet. According to its legislative history, the ACPA "protects trademarks and service mark owners while promoting the growth of electronic commerce by punishing individuals who register domain names in an attempt to profit at the expense of businesses and individuals . . . This bill presents a real opportunity to strengthen the Internet's ability to serve as a viable marketplace in the 21st century. It does so by shoring up consumer confidence in legitimate brand names, discouraging fraudulent electronic commerce, and protecting the rights of legitimate trademark and service mark holders." 145 Cong. Rec. H10828 (1999).

Congress passed the ACPA to prevent the very type of infringement that Defendants engage in today. Throughout their discussion, members of Congress emphasized the problem of infringing domains which bear a striking resemblance to those identified by plaintiffs and which are at the core of this case. "For example, one domain name registrant used the name 'wwwcarpoint.com,' without a period following the 'www,' to drive consumers who are looking for Microsoft's popular Carpoint car buying service to a competitor's site offering similar services." 145 Cong. Rec. S10515 (1999); *see also* Third Amended Complaint ("TAC") at ¶¶ 167-74 (alleging that Defendants have monetized "www," "com" and "http" domains which prey on an Internet user's failure to type in a period or colon). Congress understood that due to the nature of the Internet, infringement was occurring, and that the ACPA was needed to prevent it.

Today, through the operation of their Deceptive Domain Scheme,[1] Google and the Parking Company Defendants have taken infringement to a new level. They have created and even patented an automated process of tasting, registering and monetizing domain names that are confusingly similar to marks owned by the Plaintiffs and members of the proposed class. That automated process operates every second of the day. Given the technological developments that have enabled Defendants to engage in such large-scale infringement, class certification is the best method for adjudicating mark owners' claims and thereby upholding the intent of the ACPA.

Plaintiffs are aware of no cases either granting or denying class certification of ACPA claims. However, as shown below, a number of highly analogous copyright infringement cases – including the well-known *Napster* case which dealt with contributory and vicarious liability for large-scale infringement – have been certified. For the reasons set forth herein, certification of the ACPA claim, in addition to the more commonly certified contributory/vicarious liability claims and unjust enrichment claim, is appropriate.

[1] Unless otherwise defined herein, the terms used in this memorandum have the same meaning that they have in the TAC.

Defendants' Deceptive Domain Scheme

As set forth in the TAC, the Defendants have engaged in a massive scheme to use deceptive domain names on the internet to generate billions of advertising dollars at the expense of millions of members of the putative class. The Deceptive Domain Scheme is premised on confusion. Defendants register, license and/or "park" domain names that are confusingly similar to the Plaintiffs' distinctive trade names or marks. TAC ¶¶ 3, 131, 142. Defendants then create and maintain websites located at those Deceptive Domains that consist exclusively of advertisements from the Google AdWords program. Defendants receive ill-gotten revenue each time an Internet user who is trying to access a legitimate domain ends up at one of the confusingly similar Deceptive Domains and clicks on an advertisement located on that page. TAC ¶¶ 3, 131, 142, 139. This process is known as "monetizing" domain names that are confusingly similar to the Plaintiffs' marks. TAC ¶ 83(N). Defendants repeat this pattern of infringement over and over again, using automated, patented processes.

The TAC provides many illustrations detailing this Deceptive Domain Scheme. For example, at the time this suit was filed,[2] Defendants Google and Dotster had registered and/or otherwise controlled the domain name "wwwVulcanGolf.com." TAC ¶ 65. This domain name is confusingly similar to the domain name "www.VulcanGolf.com," which is registered to and has been used by Plaintiff Vulcan since May 1997. TAC ¶ 26. Google and Dotster monetized this domain name without the period after the "www" because they expected that internet users

[2] After this suit was filed, wwwvulcangolf.com was deleted. However, it was soon re-registered by Oversee, and Google provided another round of advertising. It was then deleted again, and as of this writing, the Deceptive Domain wwwvulcangolf.com is not registered. Defendants' records, however, establish who registered and controlled each of their Deceptive Domains at any given point in time, and Defendants will have to produce these records during discovery.

would mistype Vulcan's domain name and therefore arrive on the parked webpage that consists solely of revenue generating Google Adwords advertisements. TAC ¶ 166. Google and Dotster each participated in and performed tasks necessary to register, license, park, and/or monetize that domain with Google AdWords advertisements. Google uses its proprietary, patented, and automated technology to determine the meaning of a domain name and to determine which AdWords ads should be used to monetize the parked domain. As Google explains this process on its website: "AdSense for domains delivers targeted, conceptually related advertisements to parked domain pages *by using Google's semantic technology to analyze and understand the meaning of the domain names."* http://www.google.com/domainpark (emphasis added).

Google maintains detailed records that track and identify the total number of clicks and corresponding revenue from the AdWords ads, collects the ad revenue from the AdWords advertisers, and then distributes the revenue between itself and the Parking Company Defendant (in the preceding example, Dotster). TAC ¶ 139.

ARGUMENT

I. Standards for Evaluating Motions for Class Certification.

The United States Supreme Court has made it clear that "[c]lass actions serve an important function in our system of civil justice." *Gulf Oil Co. v. Bernard,* 452 U.S. 89, 99 (1981). The purpose of class action treatment is plain:

> The policy at the very core of the class action mechanism is to overcome the problem that small recoveries do not provide the incentive for any individual to bring a solo action prosecuting his or her rights. A class action solves this problem by aggregating the relatively paltry potential recoveries into something worth someone's (usually an attorney's) labor.

Amchem Products, Inc. v. Windsor, 521 U.S. 591, 617 (1997) (*quoting Mace v. Van Ru Credit Corp.,* 109 F.3d 338, 344 (7th Cir. 1997). Consistent with this principle, when considering whether to certify a class, a court may not concern itself with the merits of the action, or the question of who will prevail. *Eisen v. Carlisle & Jacquelin,* 417 U.S. 156, 178 (1974). As such, allegations made in support of certification are taken as true, and a district court does not examine merits of the case. *Gilbert v. First Alert, Inc*., 904 F. Supp. 714 (N.D. Ill. 1995), *amended by* 165 F.R.D. 81 (1996). A leading commentator on class actions has observed:

> [B]ecause the class action rule itself requires that the court make a class determination "as soon as practicable," and permits the court to alter or amend its order before the decision on the merits, many presumptions are fairly invoked to aid the court in reaching an early determination. Since Rule 23 is generally required to be liberally construed, these presumptions, arising at an early stage of the litigation, are invoked for the most part in favor of upholding the class.

2 Herbert B. Newberg & Alba Conte, *Newberg on Class Actions*, § 7.17 at 7-62, 63 (3d ed. 1992) (footnotes omitted) (hereinafter "*Newberg*").[3] *See also Flanagan v. Allstate Ins. Co*., 242 F.R.D. 421, 427 (N.D. Ill. 2007) ("We note that Rule 23 is to be liberally construed and that we should err in favor of maintaining a class action."); *Rogers v. Baxter International Inc.*, 2006 WL 794734, *2 (N.D. Ill. March 22, 2006) ("Doubts about whether to grant certification generally are resolved in favor of certification."). Thus, in conducting its analysis of the Rule 23 prerequisites the Court should be guided by the liberal presumptions and policies underlying Rule 23.

II. Class Definition.

Plaintiffs move for certification of the following proposed class:

> Any individual or owner of a mark whose personal name or mark is identical or confusingly similar to a parked domain name that has been registered, trafficked in or used for commercial gain, by one or more of the Defendants, during the period of time January 1, 2002 through the present.

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[3] The rule now provides that class certification be decided "at an early practicable time" rather than "as soon as practicable."

(the "Class"). The proposed class may be divided into subclasses as follows:

> Subclass 1: Owners of marks that were registered with the United States Patent and Trademark Office prior to Defendant(s) monetization of the identical or confusingly similar parked domain name.
>
> Subclass 2: Owners of marks that were not registered with the United States Patent and Trademark Office prior to Defendant(s) monetization of the identical or confusingly similar parked domain name.
>
> Subclass 3: Individuals whose personal name is identical or confusingly similar to a parked domain name.

Excluded from the class are governmental entities, Defendants, Defendants' parents, predecessors, subsidiaries, affiliates, agents and Defendants' co-conspirators and mark owners that authorized one or more of the Defendants to use their mark for commercial gain.

III. The Proposed Class Meets the Requirements of Rule 23(a)

Rule 23 of the Federal Rules of Civil Procedure, provides the following threshold requirements: (1) numerosity (the class must be so large "that joinder of all members is impracticable"); (2) commonality (there must exist "questions of law or fact common to the class"); (3) typicality (the named parties claims must be "typical ... of the class"); and (4) adequacy of representation (the representative and their counsel must be able to "fairly and adequately protect the interests of the class"). *Amchem Products,* 521 U.S. at 591.

A. The Numerosity Requirement is Satisfied.

Although there is no threshold or magic number at which joinder becomes impracticable, a class of at least forty is generally sufficient to satisfy Rule 23(a)(1). *Ringswald v. County of DuPage*, 196 F.R.D. 509, 512 (N.D. Ill. 2000) (Bucklo, J.). *See, e.g.,* 1 *Newberg* § 3.05, at 3-25. A plaintiff need not plead or prove the exact number of persons in the class, *Marcial v. Coronet*

Ins. Co., 880 F.2d 954, 957 (7th Cir. 1989), and the Court may rely on common sense assumptions or reasonable inferences. *Ringswald,* 196 F.R.D. at 511.

The numerosity requirement cannot seriously be challenged in this case. As alleged in the TAC, there are millions of geographically dispersed putative Class members. TAC ¶ 318. The numerosity requirement is therefore satisfied, as joinder of millions of plaintiffs is impracticable.

B. The Commonality and Typicality Requirements Are Satisfied

A common nucleus of operative fact is usually enough to satisfy the commonality requirement of Rule 23(a)(2). *Rosario v. Livaditis*, 963 F.2d 1013, 1018 (7th Cir. 1992) (*citing Franklin v. City of Chicago*, 102 F.R.D. 944, 949-50 (N.D. Ill. 1984)). "The test or standard for meeting the Rule 23(a)(2) prerequisite is qualitative rather than quantitative – that is, there need only be a single issue common to all members of the class. Therefore, this requirement is easily met in most cases." 1 *Newberg* § 3.10 at 48-50 (footnotes and citations omitted). Here, all of the questions of fact relating to the nature and operation of the Deceptive Domain Scheme, and Defendants' participation therein, are common to the Class. Moreover, there are numerous common questions of law that include, but are not limited to, the following:

a. Whether one or more of the Defendants' actions violate the ACPA, *15 U.S.C. § 1125(d)*;

b. Whether one or more of the Defendants' actions constitute contributory or vicarious trademark infringement;

c. Whether any of the Defendants committed or are responsible for the acts alleged herein;

d. Whether any of the Defendants' actions are continuing in nature;

e. Whether Defendants fraudulently concealed their Deceptive Domain Scheme and other unlawful activities;

f. Whether Lead Plaintiffs and the Class are entitled to declaratory and/or injunctive relief to rectify the alleged violations of law and, if so, what is the appropriate nature of the equitable and injunctive relief to which Lead Plaintiffs and the Class may be entitled;

g. Whether any of the Defendants' conduct is willful and/or intentional;

h. Whether the conduct of any of the Defendants caused damages to the Lead Plaintiffs or to the other members of the Class;

i. The appropriate measure of damages sustained by Lead Plaintiffs and other members of the Class; and

j. Whether Defendants were unjustly enriched as a result of their Deceptive Domain Scheme and other unlawful conduct.

"The question of typicality in Rule 23(a)(3) is closely related to the . . . question of commonality." *Rosario*, 963 F.2d at 1018. Typicality under Rule 23(a)(3) should be determined with reference to the defendants' actions, not with respect to particularized defenses they might have against certain class members. *Id. at 1018.* In this Circuit, the typicality requirement primarily directs a district court to focus on whether the named plaintiffs' claims have the same essential characteristics as the claims of the class at large. *De La Fuente v. Stokely-Van Camp, Inc.,* 713 F.2d 225, 232 (7th Cir. 1983). "A plaintiff's claim is typical if it arises from the same event or practice or course of conduct that gives rise to the claims of other class members and his or her claims are based on the same legal theory." *Id.* "The typicality requirement may be satisfied even if there are factual distinctions between the claims of the named plaintiffs and those of other class members." *De La Fuente,* 713 F.2d at 232.

Here, the common issues of law and fact are manifest in the Deceptive Domain Scheme. Defendants monetize parked domains on a massive scale, and to the detriment of Class members, by generating advertising revenue through confusion and deception (often capitalizing on common typographical and spelling errors). This scheme involves an automated process that is repeated by the Defendants 24 hours per day on a real time basis. It is the very existence of this uniform Deceptive Domain Scheme, and the manner in which it works, that gives rise to the issues of fact and law that are common to the Class. The named Plaintiffs' claims are also typical of the Class' claims because they are based on the same course of misconduct and the same legal theories. The Class members have all been damaged by the same systematic implementation of the Deceptive Domain Scheme.

Defendants may argue that Plaintiffs have not shown commonality and typicality here because each Plaintiff owns individual marks upon which their claims are based. But, as discussed in more detail below, it is well-settled that such differences are collateral to the gravamen of this dispute, and cannot defeat the commonality or typicality requirements. *See e.g. David v. Showtime/The Movie Channel, Inc.*, 697 F. Supp. 752, 757 (S.D.N.Y. 1988) (holding that differences among individual music publisher plaintiffs were "[i]ncidental differences [that] do not defeat commonality"). *See also Hanlon* v. *Chrysler Corp.*, 150 F.3d 1011, 1019 (9th Cir. 1998) ("All questions of fact and law need not be common to satisfy the rule. The existence of shared legal issues with divergent factual predicates is sufficient, as is a common core of salient facts coupled with disparate legal remedies within the class.").

C. The Named Plaintiffs and Their Counsel will Fairly and Adequately Represent the Interests of the Class

Courts generally consider two elements in determining whether the adequacy of representation requirement of Rule 23(a)(4) has been satisfied:

a) the plaintiff must not have interests antagonistic to those of the class; and

b) the plaintiff's attorneys must be qualified, experienced and generally able to conduct the proposed litigation.

3 *Newberg* § 3.22. The Supreme Court has expressed these elements as follows:

> What are the ingredients that enable one to be termed "an adequate representative of the class?" To be sure, an essential concomitant of adequate representation is that the party's attorney be qualified, experienced and generally able to conduct the proposed litigation. Additionally, it is necessary to eliminate so far as possible the likelihood that the litigants are involved in a collusive suit or that plaintiff has interests antagonistic to those of the remainder of the class.

Eisen v. Carlisle & Jacquelin, 391 F.2d 555, 562 (2d Cir. 1968), *rev'd on other grounds,* 417 U.S. 156 (1974). To meet adequacy of representation requirement for class certification, the court should be satisfied that named counsel is qualified to pursue the putative class action and the representatives do not have antagonistic or conflicting interests with the putative class. *Allen v. City of Chicago*, 828 F. Supp. 543, 553 (N.D. Ill. 1993).

Adequacy of class counsel cannot be seriously questioned in this case. Class counsel has a wealth of experience in class matters and has been appointed lead counsel in a substantial number of significant state and federal class actions. *See* firm resumes attached hereto as Exhibits A-B. Additionally, the named Plaintiffs do not have any interests antagonistic to the Class. Their claims arise from the same conduct by Defendants and rely on the same body of law. In sum, because there are no conflicts between the named Plaintiffs and the other Class members, and because the named Plaintiffs and their counsel will prosecute this action vigorously on behalf of the Class, this action fully satisfies Rule 23(a)(4).

D. The Class is Ascertainable.

Although there is nothing explicit in Rule 23 requiring that a proposed class be "definite" in order to be certified, there is an implied requirement that the proposed class be identifiable. *Christakos v. Intercounty Title Co.*, 196 F.R.D. 496, 500 (N.D. Ill. 2000). "[A] class is sufficiently definite if its members can be ascertained by reference to objective criteria and may be defined by reference to defendants' conduct." *Hinman v. M and M Rental Center*, 545 F. Supp.2d 802, 806 (N.D. Ill. 2008) (citation omitted).

> In fact, so long as the class is defined in terms of the defendants' conduct as opposed to the state of mind of the plaintiffs (or the defendants), and is otherwise ascertainable, the class satisfies the definiteness requirement. . . . A class so defined is of sufficient scope even if persons not presently identified are included in the class or the class membership is subject to change.

National Organization for Women v. Scheidler, 172 F.R.D. 351, 357 (N.D. Ill. 1997) (citations omitted). *See also Christakos*, 196 F.R.D. at 501 ("An identifiable class exists if its members can be ascertained by reference to objective criteria and may be defined by reference to the defendants' conduct."). Thus, while it is not necessary that each member of the class can now be identified by name, the proposed class must be sufficiently defined to demonstrate that a class exists and can be identified through discovery.[4] *Lau v. Arrow Financial Servs.*, 245 F.R.D. 620, 624 (N.D. Ill. 2007).[5]

Alliance to End Repression is the leading Seventh Circuit case on this issue. In *Alliance*, a consolidated appeal was taken from two class certification decisions by this Court (Kirkland,

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4 "[W]hether the description of a class is sufficiently definite to permit ascertainment of the class members must, of necessity, be determined on a case-by-case basis." *Alliance to End Repression v. Rockford*, 565 F.2d 975, 977 (7th Cir. 1977). *See*, *e.g.*, *Day v. Check Brokerage Corp.*, 240 F.R.D. 414, 418 n.5 (N.D. Ill. 2007) ("To the extent that Defendants are taking issue with the class definition, the ascertainability of class members is not a bar to class certification.").

5 *See also Jeffries v. Pension Trust Fund*, No. 99 Civ. 4174, 2007 WL 2454111, *14 (S.D.N.Y. Aug. 20, 2007) ("[T]he identities of individual class members are not required in order for Plaintiff to show the existence of an identifiable class."); *In re Methyl Tertiary Butyl Ether ("MTBE") Prod. Liab. Litig.*, 241 F.R.D. 185, 196 (S.D.N.Y. 2007) ("The ascertainability of a class depends on whether there will be a definitive membership in the class once judgment is rendered."); *Haywood v. Barnes*, 109 F.R.D. 568, 576 (E.D.N.C. 1986) (difficulty in immediately identifying all class members makes joinder more impracticable and certification more desirable); *Meyer v. Citizens and Southern Nat'l Bank*, 106 F.R.D. 356, 360 (M.D. Ga. 1985) ("[T]he fact that the precise number of potential members of the class cannot be ascertained does not bar class certification.") (*citing Vergara v. Hampton*, 581 F.2d 1281, 1284 (7th Cir. 1978), *cert. denied*, 441 U.S. 905 (1978)).

J.). The Seventh Circuit held that this Court did not abuse its discretion in certifying the classes. In so doing, the Seventh Circuit rejected the defendants' argument that the description of the classes in that case were too vague to define any ascertainable class:

> The important distinguishing characteristic of these two classes is that their scope is defined by the activities of the defendants. They include only those individuals and organizations operating in Chicago that have been subjected to the alleged pattern of unconstitutional harassment by the defendants. This fact alone distinguishes all of the cases cited by defendants, places this case squarely within this court's previous holding in *Illinois Migrant Council v. Pilliod*, 540 F.2d 1062 (7th Cir. 1976), *modified in part on rehearing en banc*, 548 F.2d 715 (7th Cir. 1977) (equally divided court), and creates the most compelling policy argument for certifying this class.
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> * * * *
>
> *[T]his court has made it clear that a class that satisfies all of the other requirements of Rule 23 will not be rejected as indefinite when its contours are defined by the defendants' own conduct.*

565 F.2d at 978 (emphasis added). Recognizing that to hold as the defendants requested would permit a defendant to avoid certification by expanding the scope of its illegal conduct in order to make the proposed class less well-defined, the Seventh Circuit rejected such an "extremely incongruous result" by holding that the classes certified by the district court were sufficiently definite to satisfy Rule 23. *Id.*

As noted above, in the present case, Plaintiffs propose the following Class for certification:

> Any individual or owner of a mark whose personal name or mark is identical or confusingly similar to a parked domain name that has been registered, trafficked in or used for commercial gain, by one or more of the Defendants, during the period of time January 1, 2002 through the present.

(the "Class"). The proposed class may be divided into subclasses as follows:

Subclass 1: Owners of marks that were registered with the United States Patent and Trademark Office prior to Defendant(s) monetization of the identical or confusingly similar parked domain name.

Subclass 2: Owners of marks that were not registered with the United States Patent and Trademark Office prior to Defendant(s) monetization of the identical or confusingly similar parked domain name.

Subclass 3: Individuals whose personal name is identical or confusingly similar to a parked domain name.

Here, as in *Alliance to End Repression*, Plaintiffs have defined the Class based on the Defendants' actions, *i.e.*, their wrongful conduct in registering and trafficking in parked domain names that are the same as or confusingly similar to Plaintiffs' marks. The class is therefore ascertainable.

Google maintains detailed records of every domain and advertisement that has been placed throughout the Google Network. TAC ¶ 122. Even a cursory review of Google's records will reveal thousands of monetized domain names that are identical or confusingly similar to indisputably distinctive or famous marks. Although, to date, Plaintiffs have not had the benefit of any discovery, Plaintiffs have properly alleged the existence and ascertainability of that information from records and data in the exclusion possession of Defendants. Google's detailed records which will identify every domain name Google and the parking companies monetized, as well as exactly how much profit was made and to whom the profit was distributed.

Registered trademark owners are readily identifiable from records maintained by the United States Patent and Trademark Office ("PTO"). Subclass 1 can be ascertained by comparing PTO records to Google's detailed records.

Subclasses 2 and 3 are also ascertainable through records in the exclusive possession of Defendants, and simply by virtue of the fact that Defendants have chosen to monetize a domain name that is confusingly similar to a Class member's unregistered mark or personal name. All personal names are explicitly protected under the ACPA. See 15 U.S.C. § 1125(d)(1)(a) (noting that a personal name is "protected as mark" under that section). Moreover, the fact that the Defendants were able to generate revenue from a Deceptive Domain underscores the fact that the underlying mark is distinctive and protectable under ACPA. Accordingly, such a mark is entitled to a presumption of protection. Defendants' use of automated software to generate likely typographical errors of a mark, combined with the fact that Defendants register, park and monetize the typosquatting Deceptive Domains, is also evidence that a mark was distinctive or famous enough for Defendants to generate a list of domains that are likely typographical errors of the mark. The entire domain tasting and kiting scheme utilized by Defendants is intended to determine if a Deceptive Domain is confusing enough to generate internet traffic sufficient to effectively monetize the domain.

Finally, identifying domain names that are confusingly similar to Class members' marks is a relatively straightforward task. Indeed, Google, through its own UDRP filings,[6] has identified a procedure that can be utilized to determine whether a domain name infringes upon the mark of a Class member:

1) **Prepending "www"** to a trademark yields an infringing domain. *See*, *e.g.*, *Google, Inc. v. wwwgoogle.com and Jimmy Siavesh Behain*, WIPO UDRP Case No. D2000-1240,[7] wherein Google successfully argued that a domain with a www prefix was identical or confusingly similar to a mark in which Google has rights;

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6 The Uniform Domain-Name Dispute Resolution Policy (UDRP) has been adopted by ICANN (Internet Corporation for Assigned Names and Numbers) and applies to all registrars in all gTLDs (generic top-level domains, e.g., .aero, .asia, .biz, .cat, .com, .coop, .info, .jobs, .mobi, .museum, .name, .net, .org, .pro, .tel and .travel). UDRP claims allow trademark holders to challenge infringing domain registrations in an *in rem* proceeding adjudicated by an online arbitrator.

7 http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1240.html

2) **Adding a generic word** to a trademark yields an infringing domain. *See*, *e.g.*, *Google, Inc. v. Xtraplus Corp.*, WIPO UDRP Case No. D2001-0125[8] (as to googlegear.com, googlegear.net, googlegear.org, and googlebuy.com), wherein Google successfully argued that, despite the addition of a generic word within each domain, the domains were identical or confusingly similar to a mark in which Google has rights. *See also Google, Inc. v M Minnebreuker*, WIPO Case DNL2008-0012[9] (as to koopgoogle.nl); *Google Inc. v. Office Manager a/k/a H. Hunchak*, NAF UDRP Case No. FA0205000113964[10] (as to googlepersonals.com);

3) **Adding a dictionary word or a trademark** to a trademark yields an infringing domain. See *Google Inc. v. Dmitri Rytsk*, WIPO UDRP Case No. DAU2007-0004[11] (as to googlebay.com.au), wherein Google successfully argued that, despite the addition of a generic word ("bay") or a trademark ("ebay") within the domain, the domain was identical or confusingly similar to a mark in which Google has rights;

4) **Adding a controversial or objectionable word** to a trademark yields an infringing domain. *See Google Inc. v Mikel M Freije*, NAF UDRP Case No. FA0111000102609[12] (as to googlesex.com), wherein Google successfully argued that the domain was identical or confusingly similar to a mark in which Google has rights because the addition of a generic term like "sex" does not sufficiently distinguish the mark for purposes of confusing similarity. *See also Google Technology Inc. v. Internet Hispano, S.L.*, NAF UDRP Case No. FA0307000176533[13] (as to googleporno.com). *See also Google, Inc. v. Raffaele Bassano*, NAF UDRP Case No. FA0401000232958[14] (as to googlesex.info);

5) **A simple typographical error** to a trademark yields an infringing domain. *See Google, Inc. v. Namerental.com and Leonard Bensonoff*, WIPO UDRP Case No. D2001-0060,[15] wherein Google successfully argued that ggoogle.com was identical or confusingly similar to a mark in which Google has rights because a simple typographical error is likely to cause confusion as to ownership or

[8] http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0125.html
[9] http://www.wipo.int/amc/en/domains/decisions/html/2008/dnl2008-0012.html
[10] http://domains.adrforum.com/domains/decisions/113964.htm
[11] http://www.wipo.int/amc/en/domains/decisions/html/2007/dau2007-0004.html
[12] http://www.adrforum.com/domains/decisions/102609.htm
[13] http://domains.adrforum.com/domains/decisions/176533.htm
[14] http://domains.adrforum.com/domains/decisions/232958.htm
[15] http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0060.html

affiliation of the domain name and was intended to attract users for commercial gain. *See also Google, Inc. v. Goog LR f/k/a Seocho*, NAF UDRP Case No. FA0108000098462[16] (as to googlr.com);

6) **A simple typographical error combined with addition of a dictionary word** to a trademark yields an infringing domain. *See Google Technology Inc. v. Tenacia Technologies c/o Matthew Graves*, NAF UDRP Case No. FA0306000162059[17] (as to googoljobs.com), wherein Google successfully argued that ggoogle.com was identical or confusingly similar to a mark in which Google has rights because a simple typographical error is likely to cause confusion as to ownership or affiliation of the domain name, notwithstanding the typographical error and the appendage of a generic term; and

7) **Prepending "http"** to a trademark yields an infringing domain, as does **appending "com"**, for the same reasons identified in (1). Although Google has not filed such UDRP actions, "http" and "com" are, like "www", non-substantive modifications; a domain with such a prefix or suffix is confusingly similar to the underlying mark.

Given that Google, the Defendant at the heart of the alleged Deceptive Domain Scheme, has, through its own conduct, devised a system for identifying infringing domain names, Defendants cannot credibly argue that employment of the same system to identify members of the proposed Class in this case will not be effective.[18] *See also Hinman*, 545 F. Supp. 2d at 806 (rejecting defendants' indefiniteness argument and recognizing that class members can be identified with reference to lists generated by defendants as well as by reference to M and M's conduct). Accordingly, the members of the proposed Class are ascertainable for purposes of certification under Rule 23.

[16] http://domains.adrforum.com/domains/decisions/98462.htm

[17] http://domains.adrforum.com/domains/decisions/162059.htm

[18] Should the need arise, courts may modify or narrow a proposed class definition before certifying a class. *See*, *e.g.*, *Christakos*, 196 F.R.D. at 501 (narrowing proposed consumer class in action against title company); *Xiufang Situ v. Leavitt*, 240 F.R.D. 551, 558 (N.D. Cal. 2007) (finding it appropriate to modify the class definition on those issues alleged in plaintiffs' complaint).

IV. The Proposed Class Meets the Requirements of Rule 23(b)

Where, as here, all of the requirements of Rule 23(a) have been met, the Court should next consider whether the case can be certified under any of the three categories of Rule 23(b). *See, e.g., Swanagan v. Al Piemonte Ford Sales, Inc.*, 1995 WL 493480 at *9 (N.D. Ill. August 15, 1995) (Manning, J.) ("The second part of this two-step class certification analysis requires this Court to determine whether the classes seeking certification belong to one of the categories of maintainable class actions under Rule 23(b).").

A. The Class Meets the Requirements of Rule 23(b)(3)

Rule 23(b)(3) "requires a determination that 'questions of law or fact common to the members of the class predominate over any questions affecting individual members, and that a class action is superior to other methods for fair and efficient adjudication of the controversy." *Cox v. Joe Rizza Ford, Inc.*, 1996 WL 65994 at *10 (N.D. Ill. February 9, 1996) (Manning, J.). As set forth below, both the predominance requirement and the superiority requirement are easily satisfied in this case.

1. Common Questions Predominate Over Questions Affecting Only Individual Members of the Class

The common questions of fact and law identified previously by Plaintiffs predominate over any questions affecting only individual members of the Class. As noted by this Court, "[t]he commonality requirement of Rule 23(a)(2) and the predominance requirement of Rule 23(b)(3) are closely related and a finding of one generally will satisfy the other." *Von Moore v. Simpson*, 1997 WL 570769 at *6 (N.D. Ill. Sept. 10, 1997) (Manning, J.). Moreover, it is well-settled that "[t]he presence of individual issues will not necessarily defeat class certification where there exists a predominating question of law or fact." *Thomas v. Arrow Financial*

Services, LLC, 2006 WL 2438346 at *5 (N.D. Ill. August 17, 2006). *See also In re Activision Sec. Litig*., 621 F. Supp. 415, 429 (N.D. Cal. 1985) ("The mere presence of potential individual issues does not defeat the predominance of common questions.").

(a) The Class Member's Claims All Arise from Defendants' Common Course of Conduct

While some factual variation among class members is inevitable in every case, a finding of predominance under Rule 23(b)(3) is appropriate where, as here, the complaint alleges a common course of conduct by defendants affecting all class members in the very same manner. *See Chandler v. Southwest Jeep-Eagle, Inc.*, 162 F.R.D. 302, 310 (N.D. Ill. 1995) (Castillo, J.) ("[T]he predominance requirement is satisfied even in the presence of individual questions where the critical issues are the defendant's standardized conduct towards class members[.]") (citation omitted); s*ee also Von Moore*, 1997 WL 570769 at *6 (predominance requirement "is generally satisfied when there is a 'common nucleus of operative fact' among all class members"). In cases such as this one, where claims are based upon the defendants' common course of conduct, the predominance requirement is easily met.

As Professor Newberg states:

> A single common issue may be the overriding one in the litigation, despite the fact that the suit also entails numerous remaining individual questions ... In finding that common questions predominate over individual ones in particular cases, courts have pointed to such issues that possess the common nucleus of fact for all related questions, have spoken of a common issue as the central, or overriding question, or have used similar articulations.

1 Herbert B. Newberg & Alba Conte*, Newberg on Class Actions*, § 4.25 at 4-85 to 4-86 (4th ed. 2002) (internal citations omitted). *See also In re Activision*, 621 F. Supp. at 430 ("Since the complaint alleges a 'common course of conduct'…that affected all class members in the same manner, common questions predominate.").

Here, the common course of conduct that affects all Class members in the same manner is the Deceptive Domain Scheme. Defendants use the same automated process to monetize domain names that are confusingly similar to marks owned by members of the Class or personal names of Class members. The court certified a class under virtually the same circumstances in *In re Napster, Inc. Copyright Litig.*, 2005 WL 1287611 (N.D. Cal. June 1, 2005). In that case, the plaintiffs were copyright owners whose copyrighted musical works had been made available online without their authorization through the Napster "peer-to-peer" file-sharing service. *Id.* at *3. The copyright owners did not sue the individual Internet users who had infringed their copyrights by downloading songs without the copyright owner's permission. Instead, they sought to hold the businesses whose automated software and programs made large-scale online infringement possible contributorily and vicariously liable for the Internet user's direct infringement.[19] The *Napster* court noted that "the claims of each member of the class fundamentally arise from the same factual predicate: namely, that Napster users infringed the class members' exclusive rights in one or more copyrighted musical compositions and that Bertelsmann is secondarily liable for those acts of direct infringement[.]" *Id.* at *3. The same can be said here. The claims of each member of the proposed Class fundamentally arise from the same factual predicate; namely, that Defendants licensed, trafficked in and used the Deceptive Domains and are directly liable for that conduct. Moreover, where the registrants of Deceptive Domains infringed the Class members' exclusive rights in one or more trademarks or service marks, Google and the Parking Company Defendants engaged in common course of contributory conduct, and are secondarily liable for those direct acts of infringement. Because this conduct,

[19] The defendant in the class certification proceedings was one of Napster's business partners, referred to by the court as "Bertelsmann." Napster itself sought bankruptcy protection and was not a party to the class certification proceedings. *Napster*, 2005 WL 1287611 at *1.

or common factual predicate, undoubtedly presents a "significant aspect of the case" and issues relating to that conduct can be resolved for all members of the Class in a single adjudication, there is "clear justification for handling the dispute on a representative rather than an individual basis." *Napster*, 2005 WL 1287611 at *7 (N.D. Cal. June 1, 2005) (citing 7A Charles Allen Wright et al., *Federal Practice and Procedure* § 1779 (2d ed.1986)); *see also Chamberlan v. Ford Motor Co*., 223 F.R.D. 524, 526 (N.D. Cal. 2004) (same).

With respect to Plaintiffs' unjust enrichment claims, numerous federal courts have found common issues to predominate and certified classes. *See*, *e.g.*, *Kelly v. Microsoft Corp.*, __ F. Supp.2d __, 2008 WL 509332, *14 (W.D. Wash. 2008); *Dupler v. Costco Wholesale Corp.*, 249 F.R.D. 29, 46-47 (E.D.N.Y. 2008); *In re Abbott Labs Norvir Antitrust Litig.*, Nos. 04-1511, 04-4203, 2007 WL 1689899, *8-10 (N.D. Cal. June 11, 2007); *In re Terazosin Hydrochloride Antitrust Litig.*, 220 F.R.D. 672, 697 (S.D. Fla. 2004); *Siemer v. Associates First Capital Corp.*, 2001 WL 35948712, *4 (D. Ariz. March 30, 2001). In cases where unjust enrichment claims have been certified, the question of whether defendants were unjustly enriched is susceptible to proof using common, generalized evidence. *See Terazosin*, 220 F.R.D. at 698 (holding that the same common operative facts form the basis for the classes' unjust enrichment claims); *Abbott Labs*, 2007 WL 1689899 at *9 ("Common to all class members and provable on a class-wide basis is whether Defendant unjustly acquired additional revenue or profits by virtue of an anticompetitive premium on the price of Norvir.").

Here, common proof will be used by Plaintiffs to establish whether Defendants were unjustly enriched. The common evidentiary issues that will determine whether all Plaintiffs can establish this claim include whether: (1) the defendants engaged in scheme to register, license and/or "park" domain names that are the same as or substantially and confusingly similar to the plaintiffs' distinctive trade names or marks; (2) the use of such domain names enriched defendants through the placement of advertisements on these domains; (3) such advertising profits came at the expense of Plaintiffs; and (4) Google and the Parking Company Defendants should be required to return the advertising profits and domains to the Plaintiffs.

(b) Individual Issues Do Not Predominate

Defendants will doubtless oppose class certification by conjuring up as many purported individual issues as they can imagine, including issues related to whether a class member owns a mark, whether the mark is distinctive or famous, issues relating to the appropriate measure of each class member's damages, and variations in state law. However, none of the potential individual issues in this case can overcome the common scheme perpetrated by Defendants and the numerous resulting common issues of fact and law identified above.

First, it is axiomatic that individual damage issues do not defeat class certification. *See, e.g., Murray v. Cingular Wireless II*, LLC, 242 F.R.D. 415, (N.D. Ill. 2005) (Manning, J.) ("[T]he focal point of these proceedings will be [the defendant's] alleged course of conduct in depriving putative class members of their rights under the [applicable statute]. This issue certainly predominates over any individual damages issues that might exist."). *See also Blackie* v. *Barrack*, 524 F.2d 891, 905 (9th Cir. 1975) ("The amount of damages is invariably an individual question and does not defeat class action treatment."); *Local Joint Executive Bd. Of Culinary/Bartender Trust Fund* v. *Las Vegas Sands, Inc.*, 244 F.3d 1152, 1163 (9th Cir. 2001) (holding that individual issues of damages and proof were "[not] enough to defeat predominance under Rule 23(b)(3)"); *Visa Check/Mastermoney Antitrust Litig.*, 280 F.3d 124, 139 (2d. Cir. 2001) ("Common issues may predominate…even when there are some individualized damage issues.").

Any assertion that individual damages issues should preclude certification in this case is particularly misguided given the availability of straightforward statutory damages under the ACPA.[20] Alternatively, a statistical sampling method could be devised to determine the appropriate measure of damages for each class member. *See, e.g., Hilao* v. *Estate of Marcos*, 103 F.3d 767, 786 (9th Cir. 1996) (upholding the use of statistical sampling as a method of awarding damages for a class of 10,000 members, despite difference in claims). The availability of such mechanisms allows the court to set damages at a fixed amount per violation, and thus obviates the need for any individual damages inquiry. Finally, a formula for calculating actual damages, or the monetary value of the traffic diverted from the Class Member's domain name, can be devised. In any event, whether damages are calculated based upon statutory provisions, statistical sampling or a uniform formula for calculating each class member's actual damages, those issues are secondary to the predominating issues that must be resolved to determine liability, and are properly addressed later in the proceedings. *See, e.g., Panache Broadcasting of Pennsylvania, Inc. v. Richardson Electronics, Ltd.,* 1999 WL 342392 at *7 (N.D. Ill. May 14, 1999) (noting that "the fact that the damages calculation may involve individualized analysis is not by itself sufficient to preclude certification when liability can be determined on a class-wide basis," and acknowledging that "various judicial methods [are] available to resolve individual damage issues without precluding class certification") (citation omitted).

Second, while issues relating to ownership of a mark may be relevant to determining who is properly a member of the class, they are relatively simple and can be dealt with after liability has been adjudicated. Thus, several courts have recognized in copyright infringement actions that, where a common course of infringing conduct is alleged, issues such as proof of ownership and registration are not a basis for defeating class certification. For example, in *Napster*, the court held:

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[20] See 15 U.S.C. § 1117(d), providing that "the plaintiff may elect, at any time before final judgment is rendered by the trial court, to recover, instead of actual damages and profits, an award of statutory damages in the amount of not less than $1,000 and not more than $100,000 per domain name, as the court considers just."

> [W]hile it is true that proof of ownership, registration, and actual damages ultimately requires a work-by-work inquiry, viewing these determinations as purely "individual issues" ignores the fact that the claims of every member of the class are uniformly premised upon the uploading or downloading of a copyrighted work by Napster users. This shared factual predicate in turn gives rise to a host of common legal issues concerning Bertelsmann's involvement in the operation of the Napster network. There can be no serious dispute that these issues are sufficiently "significant" to warrant adjudication of the parties' dispute on a representative rather than individual basis[.]

2005 WL 1287611 at *7 (*citing Culinary/Bartender Trust Fund*, 244 F.3d at 1162). *See also Ryan* v. *Carl Corp.*, 1999 WL 16320, at *8 (N.D. Cal. Jan. 13, 1999) (certifying class where similar issues concerning individual copyrights were present, and noting that "[b]ecause of the centrality of common issues, the issues unique to individual copyrights are reduced in importance"); *David* v. *Showtime/The Movie Channel, Inc.*, 697 F. Supp. at 756-57 (certifying class where similar issues concerning individual copyrights were present, and noting that "[c]ertainly each individual plaintiff possesses an individual copyright upon which the claim will be based," but these differences are merely "collateral to the gravamen of this dispute"). Such issues are relevant to proof of membership in the class, not whether or not class certification is appropriate. *See In re New England Mutual Life Ins. Co. Sales Practices Litig.*, 183 F.R.D. 33, 43 (D. Mass. 1998) ("No need to deny class certification exists, however, simply because any particular plaintiff may have to offer additional proof, at some point in this MDL case, to assert class membership….No basis exists in the record now before the court for concluding that, as defendant asserts, those determinations of membership for individual claimants will be so onerous as to necessitate numerous 'mini-trials,' one for each potential class member.").

Moreover, any issues relating to whether a mark is distinctive or famous, as required for ACPA protection, can be dealt with on a classwide basis. Registered marks enjoy a presumption of distinctiveness, and thus Plaintiffs can establish a prima facie case of liability for the owners of registered marks. *See, e.g., Leelanau Wine Cellars, Ltd. v. Black & Red, Inc.*, 502 F.3d 504, 513 (6th Cir. 2007) ("Registration of a mark on the Principal Register of the USPTO creates a rebuttable presumption that a trademark is valid, that is, either inherently distinctive or descriptive with secondary meaning, and therefore, protectable under federal trademark law.") (citing 15 U.S.C. § 1115(a) (providing that registration on the principal register "shall be prima facie evidence of the validity of the registered mark....")). With respect to unregistered marks, a presumption of distinctiveness is appropriate under the circumstances of this case, since the fact that Defendants selected the Deceptive Domains that were confusingly similar to the unregistered mark for monetization, and indeed profited from those unregistered marks, demonstrates a great likelihood that the marks are distinctive or famous.

Finally, with respect to Plaintiffs' unjust enrichment claims, Defendants will most likely argue that variations in state laws will outweigh the similarities, precluding class certification of Plaintiffs' unjust enrichment claims. However, federal courts have rejected this very argument. For example, the court in *Abbott Labs* recognized that differences in state law claims do not always outweigh the similarities, especially in cases concerning unjust enrichment and quoted the following from *Schumacher v. Tyson Fresh Meats*, 221 F.R.D. 605, 612-13 (D.S.D. 2004):

> Where federal claims and common law claims are predicated on the same factual allegations and proof will be essentially the same, even if the law of different states might ultimately govern the common law claims – an issue that need not and is not decided at this juncture – certification of the class for the whole action is appropriate. The spectre of having to apply different substantive laws does not warrant refusing to certify a class on the common law claims.

2007 WL 1689899 at *9.

As described above, common to all class members and provable on a class-wide basis in the present case is whether Defendants unjustly received advertising revenues by virtue of acquiring domain names that are similar to Plaintiffs' distinctive and valuable marks. Thus, any variations among state unjust enrichment laws should not preclude class certification of this claim. Accordingly, certification of Plaintiffs' unjust enrichment claims should be granted.

2. A Class Action is the Superior Method for Adjudicating these Claims

Class treatment is clearly the superior method of adjudication here. As this Court has noted, Rule 23(b)(3) "lists factors to consider including the interest of individual members in individually controlling the litigation, the desirability of concentrating litigation in a particular forum, and the manageability of the class action." *Cox*, 1996 WL 65994 at *11.

The analysis of those factors by the *Napster* court is instructive. With respect to the first factor, "the class members' interests in individually controlling the prosecution or defense of separate actions," that court noted that it was "unlikely that a significant portion of the absent class members would have the ability and desire" to pursue individual infringement actions, since many small composers "individually lack the time, resources, and legal sophistication to enforce their copyrights." *Napster*, 2005 WL 1287611 at *8. The same is true in this case, since few if any mark owners or licensees have filed suit against these Defendants in connection with their Deceptive Domain Scheme.

With respect to the second factor, the "extent and nature of any litigation concerning the controversy already begun by or against class members," the *Napster* court noted that the named plaintiffs and their counsel had participated in Napster-related litigation for years with scant involvement of the absent class members. *Id*. Similarly, this litigation has been pending for more than a year with no involvement whatsoever from any absent class member. Thus, as in *Napster*, the named Plaintiffs' "apparently satisfactory representation of the putative class strongly supports allowing plaintiffs to represent other members of the class formally." *Id*. The third factor, "the desirability or undesirability of concentrating the litigation of the claims in a particular forum," also weighs in favor of certification of this class, since concentrating the litigation in one forum would make the most efficient use of limited judicial resources. As in *Napster*, there is not "any question that considerations of judicial economy heavily favor litigating these common issues once, as part of a single class action, rather than rehashing the same questions of law and fact in each of what could amount to thousands of individual lawsuits." *Id.* at *7.

Finally, the Court must consider any "likely difficulties in managing a class action." The *Napster* court acknowledged that, "[a]dmittedly, adjudicating the ownership and damages issues pertaining to tens of thousands of separate copyrighted musical compositions will present logistical difficulties." *Id.* at *9. However, the court went to point out that "the case management problems that may arise upon certification of the class must be compared to the alternative method of adjudicating the parties' claims: that is, thousands of individual actions by individual class members." *Id.* Thus, the court concluded, "[w]hen viewed from this perspective, a class action is clearly the most efficient and in all likelihood the most equitable method for resolving the parties' dispute." *Id*. The *Napster* court's conclusion that a class action was the superior method of adjudicating the infringement claims was similar to this Court's finding of superiority with respect to the claims at issue in the *Cox* case. *See Cox* at 1996 WL 65994 at *11 ("[T]his court finds that a class action is the superior method of adjudication because (1) the number of possible litigants is not unmanageable; (2) . . . it is unlikely that individuals will file suit to protect their rights; (3) the amount of damages to each individual [class member] is relatively small, making it cost prohibitive for [individual class members] to initiate individual suits to protect their rights; and (4) efficiency favors one litigation rather than forcing individuals to litigate their own claims."). Thus, as in *Napster*, all four factors favor certification of a class in this case.

Defendants may argue that members of the Plaintiff class should resolve their claims through UDRP actions (see footnote 6 herein). However, even if the UDRP provided for a class mechanism, which it does not, Plaintiffs could not seek money damages in that non-judicial forum. *See America Online Latino v. American Online, Inc*., 250 F.Supp.2d 351, 359 n38 (S.D.N.Y. 2003) ("[T]he only relief available in a UDRP proceeding is cancellation or transfer of a domain name while a successful plaintiff in an ACPA proceeding may obtain also damages and other relief.").

In sum, there is simply no more efficient method for resolving the Class members' claims than through a representative action in this Court. The Court should find that a class action is "superior to other available methods for fairly and efficiently adjudicating the controversy." Fed.R.Civ.P. 23(b)(3).

B. The Class also Satisfies the Requirements of Rule 23(b)(2).

This Court is no stranger to certifying class actions under multiple subsections within Rule 23(b). *See Mejdreck v. The Lockformer Co.*, No. 01 C 6107, 2002 WL 1838141 (N.D. Ill. Aug. 12, 2002) (finding that plaintiffs have satisfied Rule 23(b)(3) and, alternatively, subsections 23(b)(1) and 23(b)(2)); *Tylka v. Gerber Prods. Co.*, 178 F.R.D. 493, 501 (N.D. Ill. 1998) (recognizing that classes can be certified under both 23(b)(2) and 23(b)(3)). *See also George v. Kraft Foods Global*, __ F.R.D. __, 2008 WL 2901058 (N.D. Ill. July 17, 2008) (certifying a 23(b)(1) and (2) class alleging ERISA violations); *Westefer v. Snyder*, Civil Nos. 00-162, 00-708, 2006 WL 2639972 (S.D. Ill. Sept. 12, 2006) (granting class certification pursuant to Rule 23(b)(1) and (b)(2)). Here, the Court should certify the Class not only under Rule 23(b)(3), but under Rule 23(b)(2), as well.

Professor Newberg's explanation of the requirements under Rule 23(b)(2) of the Federal Rules of Civil Procedure provides:

> Subdivision (b)(2) sets forth two basic requirements for the maintenance of class actions thereunder. First, the party opposing the class must have acted or refused to act or failed to perform a legal duty, on grounds generally applicable to all class members....The second requirement for Rule 23(b)(2) classes is that "final relief of an injunctive nature or corresponding declaratory nature, setting the legality of the behavior with respect to the class as a whole [must be] appropriate."

Newberg § 4.11 (*quoting* Rules Advisory Committee Notes to 1966 Amendments to Rule 23, 39 F.R.D. 69, 102 (1966) (emphasis added).

Unlike Rule 23(b)(3), a Rule 23(b)(2) class action does not require giving class members notice of the suit and a chance to opt out and bring their own, individual suits. This distinction results from the fact that declaratory or injunctive relief will usually have the same effect on all the members of the class. *Lemon v. International Union of Operating Engineers, Local No. 139*, 216 F.3d 577, 580 (7th Cir. 2000); *Jefferson v. Ingersoll International, Inc.*, 195 F.3d 894, 897 (7th Cir. 1999); *Holmes v. Continental Can Co*., 706 F.2d 1144, 1157 (11th Cir. 1983). When the main relief sought is injunctive or declaratory, and the damages are only "incidental," the suit can be maintained under Rule 23(b)(2). *Jefferson v. Ingersoll International Inc*., 195 F.3d at 898. The meaning of "incidental" damages is that the computation of damages is mechanical, "without the need for individual calculation," *Manual for Complex Litigation (Fourth)* § 21.221 (2004), such that separate damages suits by individual class members would unnecessary and a waste of resources. *See Allison v. Citgo Petroleum Corp.,* 151 F.3d 402, 415 (5th Cir. 1998).

Based on the foregoing, the Court should certify a class for injunctive relief that satisfies the requirements of Rule 23(b)(2). Defendants have each acted on grounds generally applicable to all of the class members in implementing the Deceptive Domain Scheme to profit from infringing upon Plaintiffs' distinctive marks. Likewise, the court can fashion relief of an injunctive or declaratory nature which prohibits and addresses the legality of the Deceptive Domains scheme with respect to the class as a whole, while also ordering Defendants to pay statutory damages under the ACPA.

C. The Class also Satisfies the Requirements of Rule 23(b)(1).

Under Rule 23(b)(1)(A), class certification is appropriate "if prosecuting separate actions by or against individual class members would create a risk of: (a) inconsistent or varying adjudications with respect to individual class members that would establish incompatible standards of conduct for the party opposing the class[.]" Courts generally restrict classes under Rule 23(b)(1)(A) "to classes where there is a statutory obligation to treat all class members alike…". *Richards v. FleetBoston Financial Corp.*, 238 F.R.D. 345, 353 (D. Conn. 2006). Class certification under Rule 23(b)(1)(A) is appropriate where each class member suffered from the same statutory violation. *Id*.

This matter clearly meets the requirements of Rule 23(b)(1)(A). Under the Deceptive Domain Scheme each member of the putative Class suffers from the exact same statutory violations. All members of the putative Class must be treated alike on these similar claims. Separate litigation would give rise to a risk of inconsistent adjudications and would create uncertainty in the law with respect to trademarks used in domains. For those very reasons, the Court certified a Rule 23(b)(1) class of copyright owners in the infringement action *David v. Showtime/The Movie Channel*, 697 F. Supp. at 757 ("If the claims in this action were litigated in piecemeal fashion, there would be a risk of inconsistency in the formulation of individual remedies, the differences between which might appear arbitrary."). A Rule 23(b)(1) class is clearly appropriate here.

V. Each Class Representative has Standing as to All Defendants.

In class actions, it is appropriate to evaluate Article III standing during the class certification analysis. *Payton v. County of Kane,* 308 F.3d 673, 680 (7th Cir. 2002) (*quoting Ortiz v. Fibreboard Corp.,* 527 U.S. 815, 831 (1999)) ("class certification issues are ... logically antecedent to Article III concerns, and themselves pertain to statutory standing.") "Article III requires that the plaintiff has suffered an 'injury in fact' which is fairly traceable to the challenged action of the defendant and 'likely,' as opposed to merely 'speculative,' to be 'redressed by a favorable decision.'" *Payton v. County of Kane*, 308 F.3d at 677 (citing *Doe v. County of Montgomery,* 41 F.3d 1156, 1159 (7th Cir.1994); *Lujan v. Defenders of Wildlife,* 504 U.S. 555, 560-61 (1992)).

Significantly, the Seventh Circuit has adopted the "juridical link doctrine." *Hudson v. Chicago*, 242 F.R.D. 496, 502 (N.D. Ill. 2007) (citing *Payton*, 308 F.3d at 679). This doctrine, which is an exception to standing, allows a class action to proceed where "the plaintiffs as a group – named and unnamed – have suffered an identical injury at the hands of several parties related by way of a conspiracy or concerted scheme, or otherwise 'juridically related in a manner that suggests a singled resolution of the dispute would be expeditious.'" *Id.*

Courts within the Seventh Circuit have consistently applied the juridical link doctrine to class actions finding that named plaintiffs are not required to have direct contact with each of the named defendants to bring their claims on behalf of a proposed class. *Id.* (although the court denied class certification on other grounds, it found that the juridical link doctrine applied after plaintiffs' provided sufficient evidence to demonstrate that they were unlawfully injured by defendants' "concerted scheme" and "common course of conduct"); *Weiss v. Winners Circle*, 1995 WL 755328 (N.D. Ill. 1995) (in an action where defendants assigned plaintiffs' contracts to various lenders, the court found that the juridical link doctrine applied because of the lenders' interrelated relationship, even through there were no actual claims between some of the plaintiffs and some of the lenders); *Contact Buyers League v. F. & F. Investment*, 300 F. Supp. 210 (N. D. Ill. 1969) (in certifying a class, the court applied the juridical link doctrine where plaintiffs argued that defendants' actions "resulted from a concert and pattern of discriminatory activity including other similar contacts").

Here, the juridical link doctrine should be applied because, as alleged in the TAC, Plaintiffs, as a group, have suffered identical injuries at the hands of Defendants who knowingly and voluntarily agreed, combined and conspired to engage in the "Deceptive Domain Scheme." TAC ¶¶ 11, 12, 90-211. Specifically, Plaintiffs all suffer from Defendants' systematic unlawful use and misappropriation of Plaintiffs' property rights and interests by knowingly monetizing and utilizing Deceptive Domains for monetary gain using Google's technology. TAC ¶¶ 1-5, 7, 11, 12, 106-107, 113-115. Significantly, Google is integral to the Deceptive Domain Scheme for a number of reasons, including the following. First Google creates, devises, contracts for, arranges, places, collects revenue from, monitors and otherwise controls almost all of the revenue-generating, advertising and marketing involved in this lawsuit. Second, Google controls and proscribes memberships and participation in the Google Network. Third, Google determines which parking companies, domain registrants, domain licensees, and domain aggregators can monetize domains, monetize Deceptive Domains, and/or otherwise participate in the Google Network and the Deceptive Domain Scheme. TAC ¶ 7. Thus, Google's facilitation of the systematic unlawful Deceptive Domain Scheme caused Plaintiffs to endure identical injuries.

In addition to the juridical link doctrine, the TAC adequately alleges specific facts against each Defendant. Such facts are pled sufficiently to prove that each Class Plaintiff is permitted to bring an action against Defendants based on their claims alleged. While the TAC does not identify a specific Deceptive Domain for each Plaintiff versus each Defendant, the chart contained in the TAC provides examples and is preceded by the unambiguous language: "Defendants taste, register, license, own, traffic in, monetize and/or otherwise utilize and control Deceptive Domains that are identical and/or substantially similar to lead Plaintiffs, *including but not limited to the following*[.]" TAC ¶ 65 (emphasis added).

Class Plaintiffs Vulcan, Blitz, Jackson and JBSS have alleged that *every one* of the named Parking Company Defendants and the numerous co-Defendants, have committed deceptive acts targeted at *every one* of the Plaintiffs. *See* TAC ¶¶ 152-154. Further, Class Plaintiffs do not limit any of the named Class Plaintiffs' claims to individual Defendants because such allegations would be inaccurate given that all of the Defendants have harmed all of the Plaintiffs. Consequently, Plaintiffs should be permitted to move forward with their claims against Defendants.

CONCLUSION

For the foregoing reasons, Plaintiffs respectfully move this Court for an Order certifying the requested Class.

Dated: August 21, 2008

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IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

VULCAN GOLF, LLC, JOHN B. SANFILIPPO & SONS, INC., BLITZ REALTY GROUP, INC., and VINCENT E. "BO" JACKSON, Individually and on Behalf of All Others Similarly Situated,	§	Civil Action No. 07-C-3371
Lead Plaintiffs,	§	Honorable Blanche M. Manning
v.	§	
GOOGLE INC., OVERSEE.NET, SEDO LLC, DOTSTER, INC., AKA REVENUEDIRECT.COM, INTERNET REIT, INC. d/b/a IREIT, INC., and JOHN DOES I-X,	§	
Defendants.	§	

CERTIFICATE OF SERVICE

I hereby certify that on August 21, 2008, I electronically filed the foregoing document with the clerk of court for the U. S. District Court, Northern District of Illinois, using the electronic case filing system of the court. The electronic case filing system sent a "Notice of Electronic Filing" to the following attorneys of record who have consented in writing to accept this Notice as service of this document by electronic means:

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